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08/121,617 09/16/93 BACKSTROM

R 020325052

EXAMINER

HALEY, J

12M2/1202

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ART UNIT

PAPER NUMBER

1201

DATE MAILED:

12/02/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11-23-94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 29-32 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-28, 33-36 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 29-32 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 071269911; filed on 11-29-87

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 1201

The amendment after final rejection submitted November 23, 1994 has been entered. Accordingly, claims 29-32 are pending. Claims 33-36 are cancelled.

The previously-indicated allowability of claims 31-32 is withdrawn in view of the following new ground of rejection. Accordingly, the finality of the previous rejection is also withdrawn.

Claims 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 5-7 of U.S. Patent No. 4,963,590. Although the conflicting claims are not identical, they are not patentably distinct from each other because compounds and compositions are obvious variants of one another since the composition may be merely a compound in water.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The obviousness double patenting rejection is being made after careful inspection of the prosecution history of the parent application. The restriction requirement issued in Paper No. 4 of the parent case was a two-way restriction between (I) compositions and methods of use and (II) a process for preparing the products. However, the claims associated with group I were original claims 1-20

Serial Number: 08/121,617

-3-


Art Unit: 1201

and 26-31. Original claims 1-20 were directed to compounds. Applicant amended claim 1 prior to examination, making it a composition claim. However, claims 2-20 remained as compound claims. Thus, the election of group I also included the election of the compounds. Therefore, this record does not reflect a restriction requirement between compositions and compounds. Thus, applicant is not protected under the provisions of 35 USC 121, and a double patenting rejection is proper.

The specification is objected to because of the following informalities:
Page 16, example 8 of Table 1 contains a group for R^3 which has an unfilled valence. The group $C=O$ does not bond to anything. Correction is required.

Any inquiry concerning this communication should be directed to Examiner Haley at telephone number (703) 308-4548. The examiner may normally be reached Monday through Friday from 8:30 am until 6:00 pm.

jh
November 30, 1994


Jacqueline Haley
Patent Examiner
Group 1200